

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 10/787,130

REMARKS

Claims 1-16 are pending in the application. Claims 5, 6 and 14 have been withdrawn from consideration. Thus, claims 1-4, 7-13, 15 and 16 have been examined in the subject application. By way of this Amendment, Applicant has amended claims 1, 7 and 9. For the following reasons, it is submitted that the application is in condition for allowance.

The Examiner continues to reject the claims for the same reasons presented in the last Office Action. More specifically, claims 7-9 have been rejected under § 102(b) as being anticipated by Yamamoto '223 (U.S. Patent No. 5,048,223); claims 7-11, 13 and 16 have been rejected under § 102(b) as being anticipated by Yamamoto '302 (U.S. Patent No. 6,105,302); and claims 1-4, 12 and 15 have been rejected under § 103 as being unpatentable over Yamamoto '302 in view of Wallace (U.S. Patent No. 3,778,916). On the other hand, the Examiner has withdrawn the objection to claims 1-3, the § 112 (first paragraph) rejection of claims 1 and 12 and the § 112 (second paragraph) rejection of claim 3. Finally, the Examiner has entered a new grounds of rejection under § 112 (second paragraph) as being indefinite.

Beginning with the § 112 (second paragraph) rejection, the Examiner contends that the limitation of the grip portion recited in claim 1 is awkward. Specifically, the Examiner does not like the language in claim 1 that the tubular transparent synthetic resin body 16 is fixed to the gripped portion 18 "through the concealing film." Although Applicant does not agree with the Examiner, to advance prosecution, claim 1 has been amended to recite that the tubular transparent synthetic resin body is fixed to the grip portion "with the concealing film disposed therebetween."

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 10/787,130

Turning to the prior art rejections, in the last response Applicant argued that independent claims 1 and 7 were patentable over the prior art due to the requirement in these claims that the tubular transparent synthetic resin body be integrally molded with the tubular body. Referring to paragraph number 8 of the Office Action, the Examiner takes the position that Applicant is arguing functional language in an apparatus claim. Specifically, according to the Examiner, the requirement in the claims that the resin body be “integrally molded” to the tubular body is functional, and not structural in nature.

Secondly, the Examiner contends that “generally, polymers and synthetic materials are molded to a desired shape and in the Yamamoto references the designated synthetic bodies were molded to a form with the tubular bodies in one-piece, integral handgrips. (sic)” Finally, the Examiner asserts that based on the figures in each patent, the designed synthetic bodies conform completely to the outer sides to the designated tubular bodies and “assure a seal between the two elements preventing water, dust, or dirt enter in between the two.”

Applicant submits that the requirement in claims 1 and 7 that the tubular transparent synthetic resin body be integrally molded with the tubular body is not a functional limitation, but rather a structural limitation. This limitation simply means that they are molded so that the resulting structure is a single piece. In contrast, despite the Examiner’s assertion to the contrary, the various elements relied upon by the Examiner in the Yamamoto references are individual elements, rather than a one-piece structure. Specifically, elements 12, 13 and 14 in Yamamoto, et al. ‘233 are clearly separate elements which are not integrally molded together. Similarly, elements 2, 42 and 43 of Yamamoto, et al. ‘302 are likewise individual elements. Thus, the

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 10/787,130

Examiner's statement that in the Yamamoto references, the designated synthetic bodies were molded to a form with the tubular bodies a one-piece integral handgrips (sic)", is simply incorrect. The various elements relied upon by the Examiner in the Yamamoto references are not integrally formed. As such, Applicant submits that the rejection of claims 1 and 7 is unsupported.

Further, with respect to the rejection of claim 1, it is submitted that the prior art does not teach or suggest an arrangement in which the tubular transparent synthetic resin body is fixed to the grip portion with the concealing film therebetween.

With respect to claim 7, according to the invention, the synthetic resin body does not contact the rod pipe because the reinforced tubular body is interposed therebetween. With this arrangement, as described on page 15 and 6 of the specification, the synthetic resin body can be formed integrally with the reinforced tubular body and thereafter the unit including the synthetic resin body and the reinforced tubular body is fitted to the rod pipe. Therefore, the number of inferior goods is decreased and the manufacturing cost is reduced.

Claim 9 is directed to the embodiment of Fig. 2 and has the same arrangement as claim 7 in that the synthetic resin body does not contact with the rod pipe. Thus, the arrangement of claim 9 provides the same advantage.

In contrast to the claimed invention, Yamamoto discloses a grip member 13 (synthetic resin member) directly formed on a rod stem member 11 (rod pipe), and discloses neither a reinforced tubular body which extends in the axial direction longer than the synthetic resin body

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 10/787,130

nor the concealing film arranged at a portion between the rod pipe and the synthetic resin body where the reinforced tubular body is not arranged.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Brian W. Hannon
Registration No. 32,778

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: July 13, 2006